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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/287,631 | 04/07/1999 | JOHN M. EBY | 03063.0396-0 | 6525 |
| 22852 | 7590 | 07/15/2003 | | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005 | | | EXAMINER | |
| | | | KUHNS, ALLAN R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1732 | |

DATE MAILED: 07/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

A3-46

| | | | |
|------------------------------|-------------------------------|----------------------------|--|
| Office Action Summary | Application No. 09/287,631 | Applicant(s) EBY ET AL. | |
| | Examiner KUHN | Group Art Unit 1732 | |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

Responsive to communication(s) filed on MAY 3, 2003 **BEST AVAILABLE COPY**

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 25 - 26, 33 - 46, 48 - 52 AND 54 - 56 is/are pending in the application.
 Of the above claim(s) _____ is/are withdrawn from consideration.
 Claim(s) 48 - 50 is/are allowed.
 Claim(s) 25 - 26, 33 - 46, 51 - 52 AND 54 - 56 is/are rejected.
 Claim(s) _____ is/are objected to.
 Claim(s) _____ are subject to restriction or election requirement

Application Papers

- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Pri ority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- All Some* None of the:
 - Certified copies of the priority documents have been received.
 - Certified copies of the priority documents have been received in Application No. _____.
 - Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892
- Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Other _____

Office Action Summary

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1. Claims 54-56 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as set forth in the previous Office action.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 25-26, 33-46 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortway et al. (4,214,028) as set forth in the previous Office action.

4. Claims 48-50 are allowed.

5. Applicants' arguments filed May 5, 2003 have been fully considered but they are not persuasive. Concerning claims 54-56, Applicants note the sentence bridging pages 11-12 of the specification which teaches that "the portion of the foam layer which has been overlayed with the design layer having the retarder composition is not mechanically embossed" and appears to argue that this provides support for the language of claims 54-56 at issue. This is not persuasive because the language bridging pages 11-12 of the specification only states what is not mechanically embossed while the language at issue requires "all" of the surface of the wear layer, except the chemically embossed portion, to be mechanically embossed. An inference is required which is not supported by the disclosure as filed.

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Applicants also argue, concerning the Shortway reference, that the claimed invention is directed to a method of making a surface covering comprising a sequence of steps neither taught nor suggested by the prior art and that Shortway at most teaches such steps in the reverse order as that instantly claimed. Applicants further argue that there can be no motivation to modify Shortway to arrive at the claimed invention, presumably still addressing the order of the steps. But the claims still at issue do not require a particular sequence of steps.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (703) 308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino, can be reached on (703) 308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Allan R. Kuhns

ALLAN R. KUHNS
PRIMARY EXAMINER AU 1732

7-13-03